

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

K.MIZRA LLC

*

* March 24, 2023

VS.

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* CIVIL ACTION NO. 6:20-CV-1031

CISCO SYSTEMS, INC.

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BEFORE THE HONORABLE ALAN D ALBRIGHT
MOTIONS HEARING (via Zoom)

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03:02 1 (Hearing begins.)

03:02 2 DEPUTY CLERK: Court calls Case
03:02 3 6:20-CV-1031, K.Mizra LLC versus Cisco Systems,
03:02 4 Incorporated. Case called for a motions hearing.

03:02 5 THE COURT: Announcements from counsel?

03:02 6 MR. SMITH: Yes, Your Honor. For the
03:02 7 plaintiff, Michael Smith, Rob Brunelli, Barr Starr,
03:02 8 Angela Bubis and Paul Cha, and Mr. Brunelli will be
03:02 9 presenting for us and we're ready to proceed.

03:02 10 THE COURT: And for defendant?

03:02 11 MS. BRANNEN: Good afternoon, Your Honor.
03:02 12 My name is Elizabeth Brannen from Stris & Maher. I
03:02 13 believe Melissa Smith, our Texas counsel, and her
03:03 14 partner, Tom Gorham, I believe they are present and
03:03 15 if -- with the Court's permission, I will be arguing.
03:03 16 Several of my clients are also here to observe and some
03:03 17 of my colleagues.

03:03 18 THE COURT: Is there any way I can stop
03:03 19 you from arguing?

03:03 20 (Laughter.)

03:03 21 THE COURT: I'm kidding.

03:03 22 MS. BRANNEN: Are you going to grant our
03:03 23 motion without an argument?

03:03 24 THE COURT: Well, let me just say I spent
03:03 25 a week in Del Rio, sentenced about 130 people, and

03:03 1 quite often I -- I said -- before their lawyers spoke,
03:03 2 I said, I'm about to give your client time served. Is
03:03 3 there anything you'd like to say? And fortunately they
03:03 4 all said no.

03:03 5 Have I had you in my court before?

03:03 6 MS. BRANNEN: Yes, Your Honor. Only
03:03 7 briefly, but it's been a privilege.

03:03 8 THE COURT: Well, welcome back. I'm glad
03:03 9 your clients have taken the time to attend. And this
03:03 10 is your motion so I will allow you to -- you're arguing
03:03 11 the motion? Okay.

03:03 12 MS. BRANNEN: Yes, Your Honor.

03:03 13 THE COURT: I'm happy -- happy for you to
03:03 14 begin.

03:03 15 MS. BRANNEN: Thank you.

03:04 16 Your Honor, there's one patent left in
03:04 17 this case, the '705 patent, and every asserted claim of
03:04 18 that patent requires a specific limitation called the
03:04 19 trusted platform module or TPM. The key question
03:04 20 presented in Cisco's motion is whether the original
03:04 21 provisional application, and that was filed in 2004, or
03:04 22 the original utility application filed in 2005
03:04 23 disclosed that limitation. And we believe we've shown
03:04 24 through our papers that on -- on a clear and convincing
03:04 25 basis that no reasonable jury could find that the

03:04 1 original disclosure actually disclosed the TPM
03:04 2 limitation. The applicant added that limitation in
03:04 3 2009 to overcome an anticipation rejection and to
03:04 4 distinguish --

03:04 5 THE COURT: So let me ask you
03:04 6 essentially -- and I look forward to this hearing.
03:05 7 Again, you know, when you -- occasionally I'm in the
03:05 8 press, and it's always clear why I like these cases and
03:05 9 it's because I actually find the lawyers to be
03:05 10 exceptional all the time, and also -- so when you say
03:05 11 that a jury wouldn't find, is it up to me to determine
03:05 12 that it's not in the application -- I get it. The
03:05 13 provision. I'm with you there, but is it up to me to
03:05 14 determine this or -- you mentioned the jury, and I
03:05 15 don't know why the jury would have a role in what
03:05 16 you're arguing, but if I -- but I ask you because, you
03:05 17 know, I'm learning this patent stuff as I go. So, you
03:05 18 know, if I don't understand something, I'm happy for
03:05 19 you to explain it.

03:05 20 MS. BRANNEN: Well, you certainly
03:05 21 understand it better than me, Your Honor, but that's
03:05 22 right. We're here to argue that as a matter of law
03:05 23 there's no question of triable fact for a jury, and so
03:05 24 I suppose --

03:05 25 THE COURT: I got it. That -- I'm good.

03:05 1 I understand that.

03:05 2 MS. BRANNEN: If we conclude they would
03:06 3 find it or could find it, then the motion -- then we
03:06 4 have to make our argument down the road, but we hope to
03:06 5 persuade you that the specification is clear under the
03:06 6 proper legal standard here. The TPM limitation is just
03:06 7 not there. It has to be there either expressly or
03:06 8 inherently. It's concededly not there expressly, and
03:06 9 although they've introduced an expert declaration, the
03:06 10 argument and the evidence that K.Mizra is proffering
03:06 11 haven't tried to meet the standard they would actually
03:06 12 have to meet to create a triable issue of fact here
03:06 13 because they haven't even tried to show that the
03:06 14 limitation is necessarily present in the disclosure
03:06 15 that exists.

03:06 16 And so we submit that if you look at the
03:06 17 intrinsic evidence under the proper legal standard,
03:06 18 this is an open-and-shut case. It's cut and dry. And
03:07 19 here, just as in Power Oasis and Turbo Care and the
03:07 20 other cases we cite, the extrinsic evidence that
03:07 21 K.Mizra is offering through its expert simply cannot
03:07 22 overcome the fundamental deficiencies in the original
03:07 23 written description.

03:07 24 Their expert in K.Mizra addressed the
03:07 25 wrong question, and they contradict the Court's claim

03:07 1 construction. And that means their facts are legally
03:07 2 irrelevant and they can't create a triable issue.

03:07 3 So if -- if time permits, I guess I would
03:07 4 do four things today. I would briefly recap the
03:07 5 relevant facts to make sure we're all on the same page
03:07 6 about the things that are conceded and the things that
03:07 7 are in question. I would briefly speak to the legal
03:07 8 standard that applies because K.Mizra's entire
03:07 9 opposition is predicated on asking the Court to apply
03:07 10 the wrong one.

03:08 11 And then I would touch on why the right
03:08 12 legal standard, the intrinsic evidence, is clear the
03:08 13 TPM limitation is missing and why the extrinsic
03:08 14 evidence misses -- just misses the mark and can't
03:08 15 actually create a triable issue of fact.

03:08 16 So for the facts, we have two
03:08 17 applications that they're pointing to and the
03:08 18 disclosures are very similar. Except for one example,
03:08 19 I think they're nearly identical. There's a
03:08 20 provisional application in 2004. Everybody agrees it
03:08 21 doesn't mention a TPM. What it does mention is a
03:08 22 different limitation called a trusted computing base,
03:08 23 and it gives one example of the trusted computing base,
03:08 24 and that example is called Palladium, an example from
03:08 25 the Palladium security initiative.

03:08 1 Then in 2005 we have the original utility
03:09 2 application. It's not disputed that that one too
03:09 3 doesn't mention the TPM limitation. The 2005
03:09 4 disclosure similarly mentions trusted computing base
03:09 5 which is the different limitation that K.Mizra is
03:09 6 trying to use to now support adequate disclosure for
03:09 7 the TPM.

03:09 8 In the 2005 application, the applicant
03:09 9 gives two different examples of what might be a trusted
03:09 10 computing base. The Palladium example's still there
03:09 11 and they add another -- which refers to various TCG
03:09 12 specifications such as the TCG Architecture Overview
03:09 13 published by the Trusted Computing Group.

03:09 14 And it's also conceded that the original
03:10 15 invention -- the claims in the original invention
03:10 16 claimed the trusted computing base. The original
03:10 17 claims did not include the TPM limitation. Nothing in
03:10 18 the 2004 or 2005 applications said anything about a
03:10 19 TPM.

03:10 20 Then in 2009, the examiner rejected the
03:10 21 pending claims over a reference called Lang, which
03:10 22 disclosed the trusted computing base the examiner
03:10 23 found, and the applicant amended the claims at that
03:10 24 time to specify that they required not just a trusted
03:10 25 computing base but a TPM associated with the trusted

03:10 1 computing base.

03:10 2 And so there's really no question of
03:10 3 explicit disclosure of the TPM limitation, and that's
03:11 4 of course the first way you can meet -- you can satisfy
03:11 5 written description. K.Mizra is hanging its hat not on
03:11 6 the -- not on disclosure of the TPM limitation but on
03:11 7 disclosure of the different limitation trusted
03:11 8 computing base. That doesn't work because they are
03:11 9 trying to elide two different claim limitations with
03:11 10 two different meanings.

03:11 11 So the -- the disclosure of a trusted
03:11 12 computing base, we say, absolutely can't suffice as a
03:11 13 matter of law to disclose the TPM.

03:11 14 Let me pause here and just note that the
03:11 15 Court has construed the term "TPM" to be a secure
03:11 16 cryptoprocessor that can store cryptographic keys and
03:11 17 that implements the trusted platform module
03:12 18 specification from the Trusted Computing Group. And
03:12 19 that's a -- that construction is available at ECF
03:12 20 No. 46 at Page 1, and that specification, the TPM
03:12 21 specification, is a different specification of the
03:12 22 Trusted Computing Group than the Architecture Overview
03:12 23 specification that the 2005 utility application
03:12 24 mentioned as an example of a trusted computing base.

03:12 25 The parties had agreed to -- K.Mizra

03:12 1 proposed and the parties agreed to a very broad
03:12 2 definition of the trusted computing base. That's any
03:12 3 hardware or software that has been designed to be part
03:12 4 of the mechanism that provides security to a computer
03:12 5 system. And it's also conceded that the Palladium
03:12 6 trusted computing base doesn't have anything to do with
03:12 7 a TPM. The -- so those are basically some of the facts
03:13 8 that I believe my colleague who will argue for K.Mizra
03:13 9 will not dispute.

03:13 10 Now, turning to the law. There is no
03:13 11 Federal Circuit case law that says that you can be
03:13 12 anything other than an express or an inherent
03:13 13 disclosure and satisfy the written description
03:13 14 requirement of 112. K.Mizra has its expert speak to a
03:13 15 theory called the default species theory, and that's
03:13 16 just not -- that's just not the right question.

03:13 17 And so I'm turning now to the second
03:13 18 topic I wanted to cover about, well, what really is the
03:13 19 law that applies here? Your Honor knows it well, so
03:13 20 I'm not going to try to give you a patent law treatise,
03:13 21 but I will try to focus on where I think the parties
03:13 22 disagree.

03:13 23 In -- in our reply brief on the first --
03:14 24 first page, we cite the Nuvo --

03:14 25 THE COURT: Can you give me just one

03:14 1 second? I'll be right back.

03:14 2 MS. BRANNEN: Oh, absolutely.

03:14 3 (Pause in proceedings.)

03:15 4 THE COURT: Okay. Thank you, ma'am.

03:15 5 You may continue.

03:15 6 MS. BRANNEN: Thank you, Your Honor.

03:15 7 So here's where I think the parties
03:15 8 fundamentally differ on the law. K.Mizra points to
03:15 9 the -- the famous and well-known part of the written
03:15 10 description test that says, well, it's very important
03:15 11 to reasonably convey to those skilled in the art that
03:15 12 the inventor had possession of the claimed subject
03:15 13 matter, but what they do is they overlook what that
03:15 14 really means in the governing case law. You know, the
03:15 15 case they cite is the Vasudevan, but it's quoting the
03:15 16 Federal Circuit's en banc decision in Ariad. Here's
03:15 17 what Ariad had to say about the possession test: The
03:16 18 term "possession," however, has never been very
03:16 19 enlightening. It implies that as long as one can
03:16 20 produce records documenting a written description of
03:16 21 the claimed invention, you could show possession, but
03:16 22 the hallmark of written description is disclosure.

03:16 23 So it's really not just did you possess
03:16 24 it? It's possession as shown in the disclosure, and
03:16 25 it's very clear that every limitation has to be present

03:16 1 in the original specification within its four corners
03:16 2 either expressly or inherently. It's not just about
03:16 3 possession. It's about did you tell the world what you
03:16 4 regarded as your invention? What the invention was?

03:16 5 The Nuvo Pharmaceuticals case that we
03:16 6 cite, Novozymes, the Lockwood case, they all make this
03:16 7 clear. And it's also the law that in a narrow set of
03:17 8 circumstances -- this is now Nuvo Pharms versus
03:17 9 Dr. Reddy -- in a narrow set of circumstances, you can
03:17 10 satisfy the written description requirement without an
03:17 11 explicit disclosure but only if the claimed features
03:17 12 are necessarily inherent in what is described.

03:17 13 And the Blazemark cases that K.Mizra has
03:17 14 pointed to are really no different. They don't use the
03:17 15 standard and they don't apply here. In the Blazemark
03:17 16 cases the Court is usually addressing a broad chemical
03:17 17 disclosure and -- kind of like a broad map. If you
03:17 18 say, well, the map of what I disclosed is Yosemite
03:17 19 park. You have to have indicated which path to take at
03:17 20 various forks. You can't just have stated all of the
03:18 21 chemical compounds and not told -- pointed anyone to
03:18 22 which ones you actually regarded in which combinations
03:18 23 as your invention, but that doesn't change the basic
03:18 24 law that every limitation has to be there.

03:18 25 And so what that means is under the right

03:18 1 legal standard, someone reading the 2004 provisional or
03:18 2 the 2005 original utility application would have to
03:18 3 have been able to read it and think, no. That the
03:18 4 applicant regarded -- had invented something that
03:18 5 required a TPM, that had the TPM as a limitation. And
03:18 6 that isn't a standard that K.Mizra has even tried to
03:18 7 meet.

03:18 8 And because the original disclosure that
03:18 9 they're resting on is a disclosure of a trusted
03:18 10 computing base with an example, namely Palladium, that
03:18 11 everyone agrees didn't require a TPM, the original
03:18 12 disclosure actually conveyed to those of skill in the
03:19 13 art the opposite of what they would have had to convey.

03:19 14 So I'll use an example here. It's one
03:19 15 that I think is actually a little bit more favorable to
03:19 16 K.Mizra than what the evidence describes. But imagine
03:19 17 that you had an original specification that said I have
03:19 18 a very tasty recipe. It's an innovative recipe. One
03:19 19 of the things you need is an aioli. And as an example
03:19 20 of what I mean by aioli, you could use Vegenaïse.
03:19 21 Something vegan, all animal products.

03:19 22 Now, everybody reading that who is
03:19 23 skilled in the art of cooking would know, okay, aioli
03:19 24 is usually garlic and oil. One example is Vegenaïse.
03:19 25 I got it. If there were then an original utility

03:19 1 application that gave two examples of aioli. Oh, one
03:19 2 could be Vegenaïse and the other could be Kraft mayo.
03:20 3 Okay? That disclosure would not support amending the
03:20 4 claims years later to say actually you have to use
03:20 5 cage-free eggs. Yes, Kraft mayo says it uses cage-free
03:20 6 eggs. Certified -- certified cage-free eggs that match
03:20 7 a certain industry certification, but that's really
03:20 8 what we have here at best for K.Mizra. We have an
03:20 9 original disclosure of aioli here, original disclosure
03:20 10 of trusted computing base, an example that doesn't
03:20 11 include the feature they added years later, then an
03:20 12 amendment in the original utility to add something that
03:20 13 they now say had that feature and to try to make it
03:20 14 very specific and comport with an industry requirement.

03:20 15 The reason that does not work is because
03:20 16 you have to tell -- if it -- if your invention requires
03:20 17 cage-free eggs, the original disclosure has to say
03:21 18 that, and it doesn't matter if someone would have
03:21 19 looked at the original disclosure and concluded that
03:21 20 adding that feature would have been obvious. Obvious
03:21 21 is not enough. But that's really the only thing that
03:21 22 the expert has at best established here.

03:21 23 Now, in the surreply, K.Mizra asks the
03:21 24 Court to treat this case similarly to the Dropbox case,
03:21 25 and so I'll just say a word about why I think the

03:21 1 expert disclosure here is very different. We almost
03:21 2 actually have the opposite situation here.

03:21 3 In that case there was a method -- there
03:21 4 was an apparatus claim that -- where the apparatus for
03:21 5 messaging had to do with three steps. There was no
03:21 6 dispute that all three steps were done, but the
03:21 7 question was whether the original disclosure had
03:21 8 support for the limitation that the steps had to be
03:22 9 done on an external messaging node. The party opposing
03:22 10 the motion had submitted an expert declaration
03:22 11 addressing a figure in the patent and some language in
03:22 12 the patent and explained why a person of skill in the
03:22 13 art would read them and find that external node
03:22 14 present. And the moving party didn't address that, not
03:22 15 with argument, not with an opposing expert declaration,
03:22 16 just didn't address it at all.

03:22 17 Here we kind of had the opposite
03:22 18 situation where the expert has said a lot of things,
03:22 19 but we have addressed them and K.Mizra has not. So the
03:22 20 problem with what the expert has said is that, first of
03:22 21 all, it speaks to the wrong legal standard. It doesn't
03:22 22 try to explain that someone reading the original
03:22 23 specification would have known that the invention
03:23 24 required or had anything to do with a TPM. Instead, it
03:23 25 addresses a legally irrelevant standard that cannot

03:23 1 suffice to create a question of fact.

03:23 2 And perhaps more importantly, it
03:23 3 contradicts the Court's claim construction. The claim
03:23 4 construction in this case makes clear that trusted
03:23 5 computing base is much broader than TPM, and so they
03:23 6 can't meet the standard they would need to meet there.

03:23 7 K.Mizra just says nothing about the fact
03:23 8 that the expert declaration that they've submitted is
03:23 9 contradicting the Court's claim construction, but it
03:23 10 would not be admissible for a jury, and for that reason
03:23 11 it can't create a triable issue.

03:23 12 I will conclude by just noting that they
03:23 13 also criticize us for quoting -- pointing out in our --
03:23 14 in our reply brief that there's a 2019 version of the
03:24 15 TPM specification that makes crystal clear that the
03:24 16 trusted platform module, the TPM, is not the same thing
03:24 17 as the trusted computing base, but that's -- that's
03:24 18 fine. The Court doesn't need to look at the 2019
03:24 19 version because we were just citing that to make clear
03:24 20 what the Court's claim construction already makes clear
03:24 21 and what the original specifications already made
03:24 22 clear, which is that a trusted computing base is much
03:24 23 broader, can be hardware or software, and it doesn't
03:24 24 have to comply with a particular specification of any
03:24 25 kind whereas the TPM is something different.

03:24 1 So in their surreply at Page 4, when they
03:24 2 say that, well, even if you consider that 2019
03:24 3 specification, the only thing that that proves is that
03:24 4 the expert declaration contradicts that specification.
03:24 5 That's really a concession that their expert
03:25 6 declaration is also at odds with the Court's claim
03:25 7 construction. Because the only reason that we pointed
03:25 8 out that statement from the 2019 TPM specification is
03:25 9 because it's so clear that the TPM and trusted
03:25 10 computing base are different things.

03:25 11 And so, Your Honor, with that, I will
03:25 12 also just point out that the Turbo Care case, the Power
03:25 13 Oasis case, all these cases that we cite make clear
03:25 14 that you can't introduce an expert -- you can't use an
03:25 15 expert to contradict or fill the gaps of what is not
03:25 16 present in an original specification, and here the TPM
03:25 17 just isn't there. It's not there expressly. It's not
03:25 18 there inherently and, therefore, we would ask you to
03:25 19 find that as a matter of law it lacks adequate written
03:25 20 description support.

03:25 21 THE COURT: Okay. A response? And let
03:25 22 me -- I have a couple things for -- in response I'd
03:25 23 like to hear first. With what counsel just said, I
03:26 24 assume the defendant -- I'm sorry. I assume the
03:26 25 plaintiff doesn't disagree with what counsel just said

03:26 1 which is that the expert can't fill in for what's
03:26 2 missing and that that's not part of your argument; is
03:26 3 that correct?

03:26 4 MR. BRUNELLI: Correct.

03:26 5 THE COURT: Okay. Now, number two, and
03:26 6 I'm going to let you say whatever you care to say, but
03:26 7 as I was getting ready for the hearing -- give me one
03:26 8 second.

03:26 9 It seemed to me that from your
03:26 10 perspective, if there is a factual dispute of, quote:
03:26 11 Whether the disclosure of the application relied upon
03:26 12 reasonably conveyed -- whether it reasonably conveys to
03:26 13 those skilled in the art that the inventor had
03:26 14 possession of the claimed subject matter as of the
03:26 15 filing date -- it's not so easy for me to say -- as
03:26 16 needed under the written description requirement.

03:27 17 What is the question I would be asking
03:27 18 the jury? How would you frame the jury question and
03:27 19 if -- if I think -- I'm not going to decide that that's
03:27 20 it today. I'd just -- I'd like to hear how you'd do
03:27 21 it, and then hear what evidence you would plan on
03:27 22 putting on to -- that would get you to the jury for
03:27 23 them to rule on that issue.

03:27 24 MR. BRUNELLI: Sure. Focusing first on
03:27 25 the visual application that includes the phrase

03:27 1 "trusted computing base," and then the -- so if we look
03:27 2 at trusted computing base as a genus and then there are
03:27 3 a number of species below it, a particular species
03:27 4 that's identified in that provisional application is
03:27 5 the Palladium specification. You then move to the
03:28 6 non-provisional application. You have both -- you
03:28 7 continue to have the trusted computing base
03:28 8 phraseologies literally, textually disclosed. You have
03:28 9 Palladium disclosed, and now you also have ECG
03:28 10 specification disclosed.

03:28 11 If we're constructing jury instructions
03:28 12 and -- the jury's going to have to be asked: What is
03:28 13 the appropriate priority date for this application?
03:28 14 The provisional date or the non-provisional date or is
03:28 15 it something else?

03:28 16 For the provisional date we'd be pressing
03:28 17 to the jury the language from the actual application,
03:28 18 the file history of the application, and what do I mean
03:29 19 there? File history makes clear that the inclusion of
03:29 20 the trusted platform module was -- species of the genus
03:29 21 of the trusted computing base was specifically
03:29 22 discussed with the examiner, and the examiner went back
03:29 23 and forth --

03:29 24 THE COURT: So let me ask you this
03:29 25 because I pretend I know what I'm -- we're doing with

03:29 1 patent law, but it -- when you say it specifically
03:29 2 discussed, is there something in the notes, in the
03:29 3 exchange, between the examiner and the counsel that was
03:29 4 dealing it, and assuming there was, I think that
03:29 5 counts, but -- you can correct me if I'm wrong and
03:29 6 opposing counsel can correct me if I'm wrong because I
03:29 7 was not a patent examiner or I didn't do patent
03:29 8 prosecution, but it seems to me looking at things from
03:29 9 your perspective that that would be intrinsic evidence
03:29 10 that the expert could testify about at trial with
03:29 11 respect to supporting your position.

03:30 12 Do I -- am I following your point?

03:30 13 MR. BRUNELLI: You are, Your Honor. And
03:30 14 an additional point to that is the examiner didn't
03:30 15 raise this written description issue, and if the
03:30 16 examiner thought there was a written description
03:30 17 problem, since the examiner is a person skilled in the
03:30 18 art, one would have expected they would have brought it
03:30 19 up at that point in time. The fact that it wasn't
03:30 20 brought up then seems to be independent evidence that
03:30 21 there is no issue there.

03:30 22 Then the third piece that we would
03:30 23 present to the jury would be the expert testimony, and
03:30 24 the expert specifically does talk about all these
03:30 25 issues. So typically the expert in their declaration

03:30 1 includes in Paragraph 29 of your declaration the actual
03:30 2 constructions of this Court, and then goes on to
03:30 3 discuss it and apply them.

03:30 4 The expert also takes quite a bit of time
03:30 5 to describe what's in the prior art. Prior art being
03:31 6 prior to 2004. And what do the people working in this
03:31 7 field prior to 2004 understand a trusted computing base
03:31 8 is? How do they use it? Why do they use it?

03:31 9 And he explains how that prior art
03:31 10 teaches to the skilled artisan what the various species
03:31 11 of a trusted computing base could be.

03:31 12 One of them --

03:31 13 THE COURT: And is -- and is the point
03:31 14 there that if -- let's assume -- I know you don't, but
03:31 15 let's assume for a second the defendant's correct with
03:31 16 their position about what's lacking that it would be
03:31 17 something that was well enough known in that time -- at
03:31 18 that time in the art such that it straps back to
03:31 19 your -- maybe a point you were making earlier where
03:32 20 both the patent examiner who's deciding whether or not
03:32 21 to allow it, it can raise the issue or the person who's
03:32 22 prosecuting the patent they may believe that it's
03:32 23 something that is well enough known at the time of the
03:32 24 art -- one skilled in the art, that they wouldn't need
03:32 25 to include what the defendant argues they needed to

1 include.

03:32 2 Am I following that correctly?

03:32 3 MR. BRUNELLI: Yes, Your Honor.

4 THE COURT: Okay. Thank you.

03:32 5 MR. BRUNELLI: Necessarily present.

03:32 6 THE COURT: Okay.

03:32 7 MR. BRUNELLI: At the time trusted

03:32 8 computing base -- what was being used was TPMs, and

03:32 9 that was the -- the generally used way -- the generally

03:32 10 used system to establish the trusted computing base.

03:32 11 Palladium was the new -- was the new kid on the block,

03:32 12 and as described in the expert's declaration and in the

03:32 13 response papers, that was the reason that was

03:32 14 specifically called out in the provisional application.

03:33 15 The inventors who were deposed also testified to that.

03:33 16 So that would be yet another, a third or

03:33 17 a fourth piece of evidence that would be presented to

03:33 18 the jury on these issues.

03:33 19 When you move up then to the

03:33 20 non-provisional application, we have all that same

03:33 21 evidence but then we would have the additional evidence

03:33 22 of the TCG specification. And if we were to look at

03:33 23 the declaration of the expert -- and by the way, the

03:33 24 only expert that has submitted a declaration on these

03:33 25 issues at this point, Your Honor.

03:33 1 If we look at Paragraph 53 through 57 of
03:33 2 that declaration, we see a number of things, one of
03:33 3 which Paragraph 53 is the Architecture Overview for
03:33 4 what the TCG Architecture Group was doing in the 2004
03:34 5 time period, and it specifically identifies the trusted
03:34 6 module right there. So that would be additional
03:34 7 evidence.

03:34 8 The final evidence would be the prior art
03:34 9 that the expert has described in his declaration that
03:34 10 we would have that expert explain to the jury. So
03:34 11 those are the six different types of evidence that we
03:34 12 expect would be placed before the jury to rebut the
03:34 13 argument of the defendant's being presented here.

03:34 14 THE COURT: And I think you were done,
03:34 15 but I'm not sure.

03:34 16 MR. BRUNELLI: The only other point is
03:34 17 that I would emphasize is written description is in
03:34 18 fact a question of fact. It goes to the jury. In this
03:34 19 particular matter there was a new piece of case law
03:35 20 submitted by Cisco just in advance of this hearing.
03:35 21 And in that case -- that's the Regents of the
03:35 22 University of Minnesota. This is Gilead Sciences case.
03:35 23 That was a decision from the Patent Trial and Appeal
03:35 24 Board, but it was after trial. So that wasn't a case
03:35 25 where it was decided on summary judgment. Those issues

03:35 1 were allowed to go through the hearing process, and the
03:35 2 factfinder, they are the board, ultimately made a
03:35 3 decision. That's what should happen here.

03:35 4 It's -- this is a question for the jury.
03:35 5 There is substantial material evidence presented. I
03:35 6 guess that wasn't my final point. My final point is,
03:35 7 I'm not aware of a single case --

03:35 8 THE COURT: I also learned not to ask it
03:35 9 that way anymore.

03:35 10 I'm kidding.

03:35 11 (Laughter.)

03:35 12 MR. BRUNELLI: My final point, I'm not
03:35 13 aware of a single case that is elevating form over
03:36 14 substance on magic words where it's -- the expert has
03:36 15 to say in his declaration it's inherently disclosed or
03:36 16 it's necessarily present. What the expert has to do is
03:36 17 provide analysis and context for why a jury would find
03:36 18 it is necessarily present or inherently disclosed. And
03:36 19 the expert in this case, again, the only expert being
03:36 20 the one presented by K.Mizra, has done that and more.

03:36 21 Now I believe I'm done.

03:36 22 THE COURT: Okay. Rebuttal?

03:36 23 MS. BRANNEN: Thank you, Your Honor.

03:36 24 I will briefly address the prosecution
03:36 25 history point and then the expert analysis point under

03:36 1 the law. So it's not the case -- it is the case that
03:36 2 whether the written description is adequate is a
03:37 3 question of fact, but Power Oasis and the other cases
03:37 4 we cite make clear that it's a question that is still
03:37 5 amenable to summary judgment when there's no disputed
03:37 6 issue of fact. And that wouldn't be the case if you
03:37 7 could always overcome summary judgment by saying, well,
03:37 8 the examiner let this issue so the examiner didn't
03:37 9 think there was a written description problem.

03:37 10 So that argument can't actually be one
03:37 11 piece of evidence especially not here, not when they're
03:37 12 relying on the original applications disclosure of one
03:37 13 limitation, trusted computing base, yet they had to add
03:37 14 the limitation in question, the TPM, to overcome an
03:37 15 anticipation rejection because the examiner said, well,
03:37 16 I'm looking at art that has a trusted computer base --
03:37 17 trusted computing base. The prosecution history here
03:37 18 is actually an express disavowal, an express rejection,
03:38 19 of the argument that they -- the about-face they now
03:38 20 have to do to say that those two things are the same
03:38 21 thing or close enough.

03:38 22 And the -- the next point I'd like to
03:38 23 make is a reference to the cases Your Honor mentioned
03:38 24 where you said, well, is this a situation where some --
03:38 25 you know, something was obvious enough, well-known

03:38 1 enough, that the written description didn't need to say
03:38 2 it? Those I think are enablement cases. Those are not
03:38 3 written description cases. The most that K.Mizra's
03:38 4 evidence establishes here is that somebody of skill in
03:38 5 the art reading the 2004 provisional or the 2005
03:38 6 original utility application that they would have
03:38 7 known, well, one way we could do a trusted computing
03:39 8 base would be to add a TPM along with it, but the law
03:39 9 on written description is very clear. And I'd ask the
03:39 10 Court to look at Lockwood, for example, which we cite
03:39 11 in our reply, which is ECF No. 82 at Page 2.

03:39 12 All the limitations must appear in the
03:39 13 specification, and similarly Power Oasis and other
03:39 14 cases make clear obvious is not enough. It's not
03:39 15 enough to look at a disclosure and say, well, I would
03:39 16 have known that one way I could have done it would be
03:39 17 to add an additional element if that element is
03:39 18 actually something your invention required. If you had
03:39 19 to have that element, then the original specification
03:39 20 has to make clear that that element is part of the
03:39 21 invention either by mentioning it expressly or by
03:40 22 disclosing it in such a way that you would know not
03:40 23 just that you could use it that way but that it's
03:40 24 necessarily present. So we are not saying that the
03:40 25 expert should be rejected because he didn't use the

03:40 1 exact words "necessarily present." If he had said, I
03:40 2 read this and I can tell you had to have it, if he had
03:40 3 used had to have it, must have had it, definitely would
03:40 4 have been there, then that might have created a triable
03:40 5 issue of fact under the actual legal standard here
03:40 6 which is that the limitation has to be explicitly
03:40 7 mentioned or inherent, meaning you read it and you know
03:40 8 it's part of the invention. You know it's necessarily
03:40 9 there.

03:40 10 What we are saying is that the intrinsic
03:40 11 evidence here is crystal clear that the original
03:40 12 specification, not the provisional in 2004, not the
03:40 13 utility in 2005, those did not describe a TPM in any
03:41 14 way, and they certainly didn't tell anybody of skill in
03:41 15 the art or anyone that a TPM was a required feature,
03:41 16 was a limitation of the invention. And that's the
03:41 17 standard they'd have to meet and it's hopeless.

03:41 18 And so we would ask that instead of
03:41 19 presenting this -- letting this go forward for a jury
03:41 20 to just be confused by an expert who's addressing the
03:41 21 wrong legal standard and who's contradicting the
03:41 22 Court's claim construction, a point I might add that
03:41 23 they've now had a third chance to address and haven't
03:41 24 denied or clarified.

03:41 25 You know, this is not a case for the

03:41 1 jury. This is a case where it's just as clear-cut as
03:41 2 if they were saying, oh, I know you construed TPM to
03:41 3 require a secure cryptoprocessor, but I want my expert
03:41 4 to speak to why this other thing is close enough. No.
03:41 5 They should not be allowed to contradict the Court's
03:41 6 claim construction. There is no TPM here, not
03:42 7 expressly, not inherently. They have not even tried to
03:42 8 meet the standard they would need to meet to get this
03:42 9 question to a jury, and so we would respectfully ask
03:42 10 that the Court find the disclosure inadequate, not in
03:42 11 2004, not in 2005, inadequate as a matter of law.

03:42 12 MR. BRUNELLI: Quick rebuttal,
03:42 13 Your Honor?

03:42 14 THE COURT: Of course.

03:42 15 MR. BRUNELLI: The expert's not
03:42 16 misconstruing the claim construction. He's applying
03:42 17 the claim construction. If I didn't make that clear in
03:42 18 my opening remarks, I'm making it clear now.

03:42 19 Second, Paragraph 33 of the expert's
03:42 20 declaration reads, and I quote: For the reasons
03:42 21 described below, a POSITA at the time of filing would
03:42 22 have understood that a TPM would form a, "root of
03:42 23 trust," in the area of, "trusted computing," generally.
03:43 24 Thus, a POSITA would have understood that a, "trusted
03:43 25 computing base," would by default be associated with a

03:43 1 TPM in an open-ended way in order to provide security
03:43 2 for computing systems.

03:43 3 If they're looking for that type of
03:43 4 language, it is in there. I'm not sure what more is
03:43 5 needed.

03:43 6 And then finally, Power Oasis came up
03:43 7 several times. An easily distinguishable case,
03:43 8 Your Honor. In that case, the District of
03:43 9 New Hampshire was construing a couple of patents. What
03:43 10 you had going on here was you had a standalone system
03:43 11 and then you had personal laptops. And the question
03:43 12 was: Did the personal -- was some of the information
03:43 13 that was disclosed in the original patent application
03:44 14 in connection with a standalone vending machine
03:44 15 properly applicable? In that case you had the original
03:44 16 non-provisional -- or provisional non-provisional, but
03:44 17 then you had a continuation in part application. And
03:44 18 in the continuation in part application, the applicant
03:44 19 actually added specific language about computers to the
03:44 20 customer's laptop, and it was that actual language that
03:44 21 was then used by the District Court in their claim
03:44 22 construction. So it's the new language that's added.

03:44 23 And it was based on that new language
03:44 24 that the Court ultimately said, well, the applicant has
03:44 25 basically admitted by having to add that language to

03:44 1 the CIP application that it wasn't there in the
03:45 2 original applications. And that was a case where they
03:45 3 were fighting over priority date, much of like what's
03:45 4 going on here. We don't have a CIP application here.
03:45 5 Very distinguishable. That's why the Power Oasis case
03:45 6 could have been decided the way it was. Here we don't
03:45 7 have any of that going.

03:45 8 And with that, thank you, Your Honor.

03:45 9 THE COURT: Anything else on behalf of
03:45 10 Cisco?

03:45 11 MS. BRANNEN: Thank you, Your Honor.
03:45 12 Yes, just briefly.

03:45 13 The continuation in part posture is not
03:45 14 what matters in Power Oasis. What matters is in
03:45 15 Power Oasis the disclosure in question was about an
03:45 16 interface on a vending machine, and there was no
03:45 17 question that the specification disclosed user
03:45 18 interfaces on a vending machine. And the patentee was
03:45 19 trying to make the argument that Your Honor alluded to
03:46 20 earlier while -- they said everybody would have
03:46 21 known -- those of skill in the art would have known
03:46 22 that you could have had the interface be remote, and
03:46 23 the Federal Circuit said not enough.

03:46 24 The disclosure of interfaces on the
03:46 25 vending machine was not enough to support a later added

03:46 1 claim that tried to claim having a remote interface
03:46 2 even though that functionality was well-known. That is
03:46 3 the point. At best all they are trying to prove is
03:46 4 that a default way of doing it might have been to
03:46 5 include a TPM, but that's not what they have to prove
03:46 6 to you. And, in fact, saying that something is a
03:46 7 default way of doing things is an acknowledgement that
03:46 8 it's not the only way of doing things. That it's not
03:46 9 an element or a required limitation of what you
03:46 10 invented.

03:46 11 And so there's no Federal Circuit case
03:46 12 out there, no Western District of Texas case, no case
03:46 13 that I can find anywhere that finds adequate written
03:47 14 description on the basis of what their expert is saying
03:47 15 which is just, hey, those of skill in the art who read
03:47 16 about a trusted computing base would have known that a
03:47 17 default way to do that would be to add an associated
03:47 18 TPM. It was newly added in 2009, and nothing in 2004
03:47 19 or 2005 told those of skill in the art that you had to
03:47 20 have one, and that's the fatal problem here.

03:47 21 THE COURT: Anything else from plaintiff?

03:47 22 MR. BRUNELLI: No, sir.

03:47 23 THE COURT: Okay. I'll be back in a few
03:47 24 seconds.

03:47 25 (Pause in proceedings.)

03:49 1 THE COURT: Let me start by saying a
03:49 2 couple of things. One, as usual, I thought the lawyers
03:49 3 did a great job. Beth tells me that she thought the
03:49 4 briefs were very good. Sometimes they are, sometimes
03:49 5 they're not, but apparently in this case they were very
03:49 6 good. And also I thought the arguments today were very
03:49 7 helpful and very informative.

03:49 8 And also I'll tell you that when Beth and
03:49 9 I were talking about this, she was going through it, I
03:49 10 think we both went back and forth a little bit and
03:49 11 thought it was a close call, but I'm going to deny the
03:49 12 motion. I will -- if we go to trial, and I assume we
03:49 13 will, I'll be listening carefully to the evidence as
03:49 14 put on and the motion -- the denial of the motion for
03:49 15 summary judgment won't in any way prohibit the
03:50 16 defendant from arguing at the end of the plaintiff's
03:50 17 case. If they want to renew this motion and I have a
03:50 18 better context of what actually has been introduced to
03:50 19 the jury, I'll be happy to do it then.

03:50 20 Also, now that you have given me a
03:50 21 heads-up on this, when we have the pretrial conference,
03:50 22 if there are issues we need to go through with this
03:50 23 with respect to either Daubert or -- gosh, I guess
03:50 24 just, you know, what might or might not be admissible
03:50 25 during trial, I've got -- hopefully I'll remember

03:50 1 enough of this that if you bring it up with me, I can
03:50 2 deal with it relatively -- with some relative awareness
03:50 3 of the issues involved.

03:50 4 I think that's the only thing we had
03:50 5 today, but I'll start with whoever -- I won't start
03:50 6 with anyone. Whoever wants to jump in and tell me
03:50 7 if -- if for plaintiff.

03:50 8 Is there anything else for defendant?

03:51 9 MR. BRUNELLI: Nothing for plaintiff
03:51 10 unless the Court wants to talk about something further.

03:51 11 THE COURT: You know, I worked harder
03:51 12 this week in Del Rio than I've worked in
03:51 13 four-and-a-half years. 130 sentencings and a criminal
03:51 14 trial, you know. And what's amazing to me is that our
03:51 15 chief judge who is in Del Rio has been doing that every
03:51 16 week for 20 years. So I don't know how that's
03:51 17 possible, but one week was enough for me and -- but I
03:51 18 got to have some great hearings this morning, and I'm
03:51 19 glad I'm getting to finish the week with good lawyers
03:51 20 and these arguments. So I don't need to hear anything
03:51 21 else.

03:51 22 Y'all have a good weekend, and I look
03:51 23 forward to seeing you in trial down the road. Take
03:51 24 care.

03:51 25 (Hearing adjourned.)

1 UNITED STATES DISTRICT COURT)
2 WESTERN DISTRICT OF TEXAS)
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5 I, Kristie M. Davis, Official Court
6 Reporter for the United States District Court, Western
7 District of Texas, do certify that the foregoing is a
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13 Certified to by me this 2nd day of April
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15
16 /s/ Kristie M. Davis
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